

REMARKS

In the Office Action¹ mailed October 5, 2009, the Examiner took the following actions:

required a new title;

required a new corrected drawing;

rejected claims 6-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

rejected claims 1 and 3-5 under 35 U.S.C. § 102(b) as being anticipated by Square Co. LTD. (JP Pub. No. 2002-2329246) ("*Square*"); and

rejected claims 2 and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over *Square* in view of Chocobo Racing (Oct. 31, 1999, page 2) ("*Chocobo*").

By the present Amendment, Applicants cancel claims 1-5 and 7 without prejudice or disclaimer and amend claims 6, 8, and 9 to more appropriately define the invention.

Support for the amendment to claim 6 may be found in now-cancelled claim 7.

Applicants also add new claims 10-15. Claims 6, 8, and 9-15 are now pending.

I. Regarding the requirement of a new title

Applicants have amended the title to read: "GAME SYSTEM WITH CHANGING CHARACTER CONTROL," as suggested by the Examiner. The new title is indicative of the invention to which the claims are directed, and Applicants respectfully request withdrawal of the objection to the specification.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. Regarding the requirement of a new corrected drawing

Applicants submit herewith a replacement sheet containing a lighter and clearer version of Figure 4. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the objection to the drawings.

III. Regarding the rejection of claims 6-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter

On page 2 of the Office Action, the Examiner rejected claims 6-9 under 35 U.S.C. § 101 alleging that “the claimed invention is directed to non-statutory subject matter.” Applicants respectfully traverse this rejection. To advance prosecution, however, Applicants amend claim 6 to recite “[a] computer-readable medium storing instructions for configuring a processor to perform a method for performing a relay race game.” Applicants have also amended dependent claims 8 and 9 to be consistent with claim 6. Applicants’ amendments to claims 6, 8, and 9 are consistent with the guidelines contained in the U.S. Patent and Trademark Office’s recently issued *Interim Examination Instructions Evaluating Subject Matter Eligibility under 35 U.S.C. § 101* (Aug. 2009) (the “*Interim Instructions*”) to ensure recitation of patent eligible subject matter. See *Interim Instructions* at 4.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6, 8, and 9 under 35 U.S.C. § 101.

IV. Regarding the rejection of claims 1 and 3-5 under 35 U.S.C. § 102(b)

Applicants respectfully traverse this rejection. However, this rejection is rendered moot by the cancellation of claims 1 and 3-5.

V. Regarding the rejection of Claims 6, 8, and 9 under 35 U.S.C. § 103(a)

Applicants respectfully traverse this rejection.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim “Office personnel must explain why

the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established, because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed combinations and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed combinations obvious to one of ordinary skill in the art.

Independent claim 6 recites a method including, for example: “a decision process ... [to decide] whether or not [a game] character is positioned within a predetermined distance range from [a] reference point [and] a notification process ... [that provides] a display which notifies a change over of operation ... on the game screen of the player who operates the next [game] character” (emphasis added). Further, independent claim 6 recites a method including, for example: “a change over timing calculation process of ... calculating timing at which [the] operation change over is [to be] performed, based on the distance between [a game] character and [the] reference point” (emphasis added). Contrary to assertions in the Office Action, the applied prior art does not teach or suggest at least these elements of claim 6.

Page 6 of the Office Action asserts that “*Square* substantially discloses the invention as claimed but fails to teach a relay racing game” (emphasis added). Applicants respectfully disagree.

Square discloses only that when a “player chooses a ‘game’ from the ... menu, the message for which it refers to a player will be displayed ... [allowing the] selection of a [cooperation] shift play mode in which two or more players [may] operate a common player character” (paragraph 29). However, this does not constitute “a decision process ... [to decide] whether or not [a game] character is positioned within a predetermined distance range from [a] reference point” as recited in claim 6 (emphasis added).

Further, page 3 of *Chocobo* discloses only a relay race involving “a team of three racers against another team in a tag team sort of match-up. When a character reaches a specific point where another racer is waiting, that racer then takes over until the next checkpoint.” However, this does not constitute “a decision process ... [to decide] whether or not [a game] character is positioned within a predetermined distance range from [a] reference point” as recited in claim 6 (emphasis added).

Page 8 of the Office Action asserts that “a notification process ... which notifies a change over of operation of [the] current ... character” is disclosed in paragraphs 29-33 of *Square* and on page 3 of *Chocobo*. Applicants respectfully disagree.

Square discloses only that when a “player chooses a ‘game’ from the ... menu, the message for which it refers to a player will be displayed ... [allowing the] selection of a [cooperation] shift play mode in which two or more players operate a common player character” (paragraph 29). Further, *Square* discloses the ability to “change a common player character by choosing a ... play mode ... [and that the] player can perform a chat and can look for the cooperation player which plays together” (paragraphs 30-31).

Further, *Square* discloses that “a player will choose the map ... [and selection] of the

map ... will display a window for setting up the operation shift conditions” (paragraphs 32-33). However, this does not constitute “a notification process ... [that provides] a display which notifies a change over of operation ... on the game screen of the player who operates the next [game] character” as recited in claim 6 (emphasis added).

While page 3 of *Chocobo* generally discloses a relay race in which “a character reaches a specific point where another racer is waiting, that racer then takes over,” *Chocobo* clearly fails to disclose or suggest “a notification process ... [that provides] a display which notifies a change over of operation ... on the game screen of the player who operates the next [game] character” as recited in claim 6 (emphasis added).

Page 8 of the Office Action further asserts, with regard to now-cancelled claim 7, the limitations of which have been added to claim 6, that “a change over timing calculation process of ... calculating timing at which [the] operation change over is [to be] performed, based on the distance between [a game] character and [the] reference point” is disclosed in paragraphs 29, 30, 36, and 44 of *Square*. Applicants respectfully disagree.

As noted above, paragraph 29 of *Square* discloses only that when a “player chooses a ‘game’ from the ... menu, the message for which it refers to a player will be displayed ... [allowing the] selection of a [cooperation] shift play mode in which two or more players operate a common player character.” Paragraph 30 of *Square* discloses only “the ability to operate [the game] while two or more players ... operate two or more video game devices.” Paragraph 36 of *Square* discloses that “one player continues operating [a player character for] a fixed time” (emphasis added). Paragraph 44 of

Square discloses only that “after a game start, the [first] player can operate a player character ... and the operating command by other players is not received.” However, none of these disclosures constitute “a change over timing calculation process of ... calculating timing at which [the] operation change over is [to be] performed, based on the distance between [a game] character and [the] reference point” as recited in claim 6 (emphasis added).

Page 9 of the Office Action cites *Hightower* as an analogous reference, against claim 8, disclosing a ghosting feature in which a translucent character is overlapped with the character at a certain point to increase player appeal. Without acceding to the characterization of *Hightower* as stated in the Office Action, *Hightower* fails to overcome any of the above-noted deficiencies of *Square* and *Chocobo*.

In view of the mischaracterization of the prior art, as set forth above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the matter of claim 6. Thus, no reason has been articulated as to why one of ordinary skill in the art would find the invention obvious. For at least these reasons, no *prima facie* case of obviousness has been established against claim 6. Therefore, claim 6 is patentable.

Claims 8 and 9 depend from claim 6 and are thus patentable over *Square*, *Chocobo*, and *Hightower*, for at least the reasons discussed above in regard to claim 6.

VI. Regarding New Claims 10-15

Applicants have added new claim sets 10-12 and 13-15 that each generally correspond to claim 6, 8, and 9, respectively, and are therefore patentable for the reasons set forth above regarding claims 6, 8, and 9. Further, claims 10-12 are directed to a computer device and claims 13-15 are directed to a method consistent with guidance contained in the *Interim Instructions*, to ensure they recite patent eligible subject matter.

Applicants therefore request the Examiner's consideration and allowance of new claims 10-15.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the cited references. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

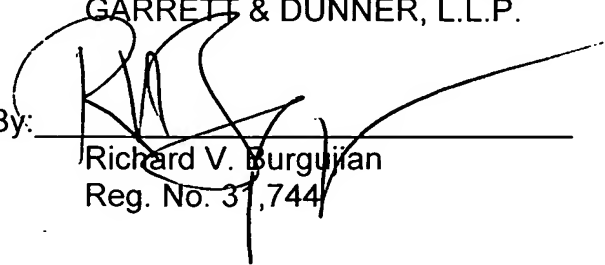
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 29, 2009

By:


Richard V. Burguijan
Reg. No. 31,744